

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed August 6, 2003.

Currently, claims 1-9 are pending. Applicants have amended claims 5, 7, and 9. Applicants respectfully request reconsideration of claims 1-9.

**I. Summary of the Examiner's Objections**

Claims 5, 7 and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6 and 8 are rejected under 35 U.S.C. §102(e) as being anticipated by Johnson (U.S. 2002/0047471 A1) (hereinafter Johnson I).

Claims 2-5, 7 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson (U.S. 2002/0047471 A1) in view of Johnson (U.S. 2002/0016912 A1) (hereinafter Johnson II).

**II. Summary of the Amendments**

Claims 5, 7 and 9 have been amended.

**III. Remarks**

It is respectfully submitted that claims 5, 7, and 9 as amended particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is respectfully submitted that the Johnson I reference, U.S. 2002/0047471 A1, is not prior art under 35 U.S.C. §102(e).

Johnson is a publication of a patent application having a filing date of August 1, 2001. The present application was filed July 19, 2000. It is only available as a reference under §102(e) by virtue of its claim to continuation in part status from parent applications as follows:

- Continuation in Part of Application serial no 09/239,425 filed January 28, 1999 (which issued as U.S. Patent No. 6,499,108);
- Continuation in part of application serial no 09/255,8371 filed February 23, 1999;
- Continuation in part of Application serial no 08/892,982 filed July 15, 1997, which issued as U.S. Patent No. 5,970,149.

It is respectfully submitted that the disclosures of the cited parent applications do not provide sufficient disclosure to support the use of Johnson I in the rejections, and hence does not have an effective filing date prior to the instant application under 35 U.S.C. §102(e). Johnson I is only effective as a reference as of its actual filing date of August 1, 2001.

Attached as Exhibit A hereto are copies of United States Patent Nos. 6,499,108 and 5,970,149. As even a brief review of these disclosures shows, the disclosures do not share even one figure in common with each other, or the Johnson I disclosure.

Attached hereto as Exhibits B and C is a Microsoft Word Document "Document Compare" between the text of the Description of Johnson I and each said respective patent as published on the United States Patent Office Web Site. In the compare documents, only text which is neither underlined nor stricken-through is common to both documents.

As a review of the documents shows, and as validated by the document comparisons attached hereto as Exhibits B and C, there is no similarity in the parent disclosure from which 2002/0047471 A1 claims priority which would support the rejections set forth by the Examiner. In fact, there is barely any similarity between the publication and the parent applications at all.

No published information concerning the grandparent application from which CIP status

---

1 No matching published document for this application serial number was found in a search of USPTO records.

is claimed – application serial no. 09/255,837 has been found. Given the gross dissimilarity between both the parent application 6,499,108 and the great-grandparent application 5,970,149, and given the fact that the '149 patent predates this disclosure, it is respectfully submitted that such reference could not provide support the 35 U.S.C. § 102(e) rejection.

Hence, the rejections under 35 U.S.C. §102(e) cannot be maintained. In particular, the Johnson I reference fails under 102(e) because it is not

... described in - (1) an application for patent, published under section 122(b), by another *filed in the United States before the invention by the applicant for patent ..*

as required by 35 U.S.C. §102(e).

As noted in M.P.E.P. §706.02(f)(1),

For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims priority under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C. 119(e) or 120. (Emphasis Added).

Without the proper antecedent support in the parent applications, the Johnson I patent can only be accorded the August 1, 2001 filing date, antecedent to applicants filing date.

Moreover, the rejections under 35 U.S.C. § 103 are based on Johnson as a primary reference, and therefore likewise cannot be maintained.

Based on the above amendments and these remarks, reconsideration of claims 1-9 is respectfully requested.

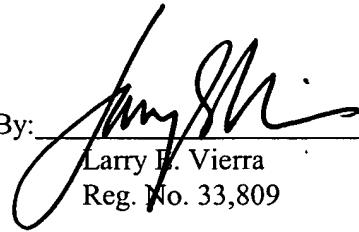
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, January 6, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: Jan 6, 2004

By: 

Larry E. Vierra  
Reg. No. 33,809

VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 Market Street, Suite 540  
San Francisco, California 94105-4206  
Telephone: (415) 369-9660  
Facsimile: (415) 369-9665